

## **Remarks**

### **I. Status of Claims**

Claims 9-13, 21-30, and 36-39 are pending.

Claims 11, 21, 22, 25, 30, and 38 have been rewritten in independent form in response to the Examiner's indication that such claims would be allowable.

Claims 12 and 13 depend from independent claim 11 and therefore are in condition for allowance for at least the same reasons.

Claims 23 and 24 depend from independent claim 22 and therefore are in condition for allowance for at least the same reasons.

Claim 26 depends from independent claim 25 and therefore is in condition for allowance for at least the same reasons.

### **II. Claim objections**

Claim 39 has been amended in a way that corrects the typographical error noted by the Examiner. The objection to this claim now should be withdrawn.

### **III. Claim rejections under 35 U.S.C. § 102/103**

The Examiner has rejected claims 9, 10, 27-29, 36, 37, and 39 under 35 U.S.C. § 102(b) or § 103(a) over Watson (U.S. 3,847,718).

#### **A. Independent claim 9**

Independent claim 9 has been amended and now recites:

9. A bookbinding system, comprising:
  - a sheet binder configured to bind with an adhesive two or more sheets into an adhesively bound text body having an exposed spine bounded by two exposed side hinge areas;
  - an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body; and

a cover binder configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover.

In Watson's approach, the text body is not bound with an adhesive until after the pressure sensitive adhesive strips 40 have been attached to the unbound sheets of the book 15. In particular, Watson explains that (emphasis added):

In use, cover strips 41 are removed to expose the adhesive 40 which, on application of pressure following insertion of the book 15 therebetween as described earlier, bonds the sides of substrate 12 to the outer pages of the book 15. The application of heat and pressure to the center portion or base of substrate 12 activates the low tack adhesive comprising stripe 14 to complete the bond in the manner described heretofore.

The reference to the earlier description in the underlined portion of this explanation corresponds to col. 4, lines 37-38, where Watson explains that "the loose pages comprising the book 15 are placed, edge first, on adhesive strip 14."

Therefore, Watson does not teach or suggest an adhesive dispenser that is configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of an adhesively bound text body as recited in claim 9.

For at least these reasons, the Examiner's rejection of claim 9 under 35 U.S.C. §102/103 over Watson should be withdrawn.

The Examiner's rejection of claim 9 also should be withdrawn for the following additional reason:

1. In the rejection of claim 9, the Examiner has stated that Watson discloses a sheet binder in col. 4, lines 36-38. This disclosure states that "the loose pages comprising the book 15 are placed, edge first, on adhesive strips." In accordance with the Examiner's position, a person who places the loose sheets on the adhesive strips constitutes the "sheet binder" recited in claim 9 (see page 6, lines 3-4, of the Office action).
2. In the rejection of claim 9, the Examiner has stated that Watson discloses an adhesive dispenser in col. 2, lines 63-67. This disclosure states that the adhesive "binding means, which could be conveniently supplied in the form of a roll, would be cut to size at the time of use." This disclosure does not describe an adhesive dispenser that applies a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body. Clearly, a roll of the binding means 10 is not configured to apply the binding means 10 to the loose pages of the book 15. Instead, some mechanism must manipulate the roll in order to apply the binding means 10. Thus, in accordance with the Examiner's position, the same person who constitutes the "sheet binder" also constitutes the "adhesive dispenser" recited in claim 9.

3. In the rejection of claim 9, the Examiner has stated that Watson discloses a cover binder in col. 4, lines 38-46, and col. 5, line 65 - col. 6, line 2. This disclosure describes a manual process of bonding the loose pages of the book 15 to one another and the substrate 12. Thus, in accordance with the Examiner's position, the same person who constitutes the "sheet binder" and the "adhesive dispenser" also constitutes the "cover binder" recited in claim 9.

In summary, the Examiner has relied on the same person to meet the "sheet binder", the "adhesive dispenser", and the "cover binder" elements of claim 9. Therefore, the Examiner's rationale impermissibly relies on a single element of Watson's disclosure (i.e., the person carrying out the steps of the disclosed method) to meet three separate and distinct elements of claim 9, effectively reading two of these elements out of the claim. For example, if the Examiner chooses to assert that the person corresponds to the "sheet binder" recited in claim 9, then the Examiner will have failed to specifically point to element of Watson's disclosure that corresponds to the "adhesive dispenser" and the "cover binder" elements of claim 9.

For the reasons explained above, Watson does not teach or suggest all of the features of claim 9 and therefore the rejection of claim 9 under 35 U.S.C. §102/103 over Watson should be withdrawn for this additional reason (see MPEP § 706.02(j)).

In an effort to sidestep these failures of Watson's disclosure, the Examiner has stated that (the paragraph beginning at the bottom of page 3 of the Office action):

It should be noted that the claim as currently written does not require the sheet binder and cover binder to be mechanically or automatically performed. However, in the alternative, it would have been obvious to have replaced a manual system for sheet and cover binding with an automatic system for the purpose of increasing production capability, as it has been held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

In this statement, however, the Examiner has not explained how one skilled in the art at the time the invention was made would have been led to replace the unspecified "manual system for sheet and cover binding" with the unspecified "automatic system". Nor has the Examiner provided any explanation regarding how such a person would have been led to make such a replacement in a way that arrives at the invention bookbinding system recited in claim 9. Consequently, contrary to the Examiner's assumption, the statement quoted above

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does not establish a *prima facie* case of obviousness under 35 U.S.C. § 103 (see MPEP § 706.02(j)).

B. Claims 10, 27-29, 36, 37, and 39

Each of claims 10, 27-29, 36, 37, and 39 incorporates the features of independent claim 9 and therefore is patentable over Watson for at least the same reasons explained above.

IV. Conclusion

All of the pending claims are now in condition for allowance and should be allowed.  
Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

Respectfully submitted,

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